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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/724,564

Filing Date: November 26, 2003

Appellant(s): BEIMESCH, WAYNE EDWARD

Xiaoyue Peter Chen, Ph. D  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 01 July 2008 appealing from the Office action mailed 14 February 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

This application is a divisional of copending application 09/806,274 which is now at the Board of Patent Appeals and Interferences for the second time.

On 19 March 2004 the Board reversed the rejections of the 09/806,274 claims which included both process- and apparatus-type claims. After the Office reopened prosecution of the 09/806,274 application the appellant filed this application to pursue the apparatus claims, and left the process claims pending and under appeal in the 09/806,274 application.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. No amendment after the 02/14/2008 final rejection has been filed by the appellant.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

<u>Reference</u>	<u>Inventor(s)</u>	<u>Issue/Publication Date</u>
U.S. Patent 4,930,906 A	Hemphill, Fred S.	06-1990

Other References/Citations:

*In re Ngai*, 70 USPQ2d 1862 (Fed. Cir. 2004)

**(9) Grounds of Rejection**

Claims 23-34 stand as rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent 4,930,906 to Hemphill.

Hemphill discloses an enclosed bag (reference item 10) and having instructions (reference items 18 and 20). Hemphill's bag, being foldable, is also inherently collapsible in that it is formed of thin plies of materials. The enclosed bag also has a maximum fill line (reference item 19). This bag, when sealed, would have a headspace above the maximum fill line. Hemphill's bag is formed of a multi-ply construction. The inner layer (reference item 13) is formed of aluminum. The intermediate layer (reference item 11) is formed of polyethylene. The outer layer (reference item 13) is formed of paper.

According to Hemphill the outer paper layer is provided to "protect an individual from being burned by the hot grease." See column 4 (lines 26-28). It is considered obvious to eliminate the outer paper layer when protection from hot grease is not an issue. For example, the bag could be used to store cooler materials, including cold grease, so that burning is not design consideration. See also MPEP §2144.0 4:

***A. Omission of an Element and Its Function Is Obvious If the Function of the Element Is Not Desired***

*Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989) (Claims at issue were directed to a method for inhibiting corrosion on metal surfaces using a composition consisting of epoxy resin, petroleum sulfonate, and hydrocarbon diluent. The claims were rejected over a primary reference which disclosed an anticorrosion composition of epoxy resin, hydrocarbon diluent, and polybasic acid salts wherein said salts were taught to be beneficial when employed in a freshwater environment, in view of secondary references which clearly suggested the addition of petroleum sulfonate to corrosion inhibiting compositions. The Board affirmed the rejection, holding that it would have been obvious to omit the polybasic acid salts of the primary reference where the function attributed to such salt is not desired or required, such as in compositions for providing corrosion resistance in environments which do not encounter fresh water.). See also *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) (Omission of additional framework and axle which served to increase the cargo carrying capacity of prior art mobile fluid carrying unit would have been obvious if this feature was not desired.); and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (deleting a prior art switch member and thereby eliminating its function was an obvious expedient).

Official notice was taken in a previous office action that aluminum foil is a material that inherently does not release significant amounts of volatile organic compounds (VOCs). The applicant did not traverse this official notice. Rather, the applicant agrees with this statement. See page of the response filed 9/18/07:

With respect to Claim 23, Applicant recognizes that the Examiner's official notice that aluminum foil is a material that does not release significant amounts of volatile organic compounds (VOCs).

Therefore, this is now factual prior art.

With regard to claims 23 and 25 the phrase "for measuring the volatile organic compounds of a substance" is not being affording any patentable weight. This phrase amounts to how the kit is to be used and does change or otherwise impact the structure of the kit. As the appellant is fully aware a recitation of the intended use of the claimed

invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With regard to claim 24 the phrase "for measuring the volatile organic compounds of a substance produced in a process system having emissions" is not being affording any patentable weight. This phrase amounts to how the kit is to be used and does change or otherwise impact the structure of the kit. As the appellant is fully aware a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With regard to claim 23 (lines 5-7) the claimed bag is formed of materials that do not release significant amounts of VOCs. A review of the appellant's written description shows that the sole disclosed embodiment for the bag is one formed of an aluminum inner layer and a polyethylene outer layer. Therefore, aluminum and polyethylene are materials that do not release significant amounts of VOCs. The bag of Hemphill, when the paper layer is omitted, is also formed of aluminum and polyethylene and, therefore, will also be formed of materials that do not release significant amounts of VOCs.

With regard to claim 24 (lines 6-8) the claimed bag is formed of materials that can be safely stored at the exit temperature of a process system. A review of the applicant's written description shows that the sole disclosed embodiment for the bag is one formed of an aluminum inner layer and a polyethylene outer layer. Therefore,

aluminum and polyethylene are materials that can be safely stored at the exit temperature of a process system. The bag of Hemphill, with or without the paper layer, is also formed of aluminum and polyethylene and, therefore, will also be formed of materials that can be safely stored at the exit temperature of a process system.

With regard to claim 25 (lines 5-7) the claimed bag consists of two layers, one being an impermeable inner layer and one being a polymer outer layer. A review of the applicant's written description shows that the sole disclosed embodiment for the bag is one formed of an aluminum inner layer and a polyethylene outer layer. The bag of Hemphill, without the paper layer, will consist of two layers wherein the inside layer (reference item 13) is the vapor impermeable aluminum layer and the outer layer (reference item 11) is made of a polyethylene polymer.

With regard to claim 32 (lines 3-5) the claimed bag has a wall consisting of an inner liner and an outer liner that do not release significant amounts of VOCs. A review of the appellant's written description shows that the sole disclosed embodiment for the bag is one formed of an aluminum inner layer and a polyethylene outer layer. Therefore, aluminum and polyethylene are materials that do not release significant amounts of VOCs. The bag of Hemphill, without the paper layer, will have a wall consisting of two liners wherein the inside aluminum liner (reference item 13) and the outer polyethylene liner (reference item 11). The bag of Hemphill, when the paper layer is omitted, will also be formed of materials that do not release significant amounts of VOCs.

In all Hemphill teaches a kit that meets the structural limitations of the applicant's claims. Hemphill, however, does not teach specific instructions with regard to sampling and analyzing. In the precedential decision *In re Ngai*, 70 USPQ 2d 1862, the Court of Appeals for the Federal Circuit (CAFC) reviewed a situation clearly analogous to the applicant's claims. In Ngai *et al.* a kit was claimed was claimed as follows (emphasis added):

19. A kit for normalizing and amplifying an RNA population, said kit comprising instructions describing the method of claim 1 and a premeasured portion of a reagent selected from the group consisting of: oligo dT biotinylated primer, T7 RNA polymerase, annealed biotinylated primers, streptavidin beads, polyadenyl transferase, reverse transcriptase, Rnase H, DNA pol I, buffers and nucleotides.

The CAFC analyzed Ngai *et al.*'s claim 19 and determined that the elements that formed the kit included a premeasured portion of reagent and instructions on how to use the reagent. The cited prior art was a kit having a 10X buffer and specific instructions on how to use the 10X buffer. In referring to *In re Gulack*, 703 F.2d 1381 [217 USPQ 401] (Fed. Cir. 1983), the CAFC stated:

"This case [Ngai], however, is dissimilar from *Gulack*. There the printed matter and the circularity of the band were interrelated, so as to produce a new product useful for "educational and recreational mathematical" purposes. Here, addition of a new set of instructions into a known kit does not interrelate with the kit in the same way as the numbers interrelated with the band. In *Gulack*, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result. Here, the printed matter in no way depends on the kit, and the kit does not depend on the printed matter. All that the printed matter does is teach a new use for an existing product. As the *Gulack* court pointed out, "[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." *Id.* If we were to adopt Ngai's position, anyone could continue patenting a product indefinitely provided that they add a new instruction sheet to the product."

The CAFC affirmed the Board of Patent Appeals and Interferences (BPAI) and concluded that Ngai *et al.*'s claimed kit was anticipated by the prior art (the 10X buffer with instructions), despite the fact that Ngai *et al.*'s claim 1 method was distinct from the instructions in the prior art. In fact, the method of claim 1 was determined to be patentable over the prior art. The CAFC further concluded that Ngai *et al.*'s instructions merely taught how to use the reagent component of the kit (the 10X buffer). Specifically, the CAFC concluded:

"All that the printed matter does is teach a new use for an existing product."

and

"He [Ngai] is not, however, entitled to patent a known product by simply attaching a set of instructions to that product."

In the present application the instructions merely teach a different use for a known sealable bag. The appellant's claimed enclosed bag does not depend on the claimed instructions in order to function; i.e., the instructions do not enable the bag to hold a sample. Likewise, the claimed instructions do not depend on the bag in order to instruct someone how to sample. Therefore, the appellant's instructions do not enable any sealable bag from holding any material and only describe a process to store a sample in the bag and then to sample the headspace of the bag.

The applicant's claims for a kit comprising a bag and instructions to use the bag is clearly analogous to Ngai *et al.*'s kit having a known reagent (the 10X buffer) and instructions that taught how to use the reagent. The appellant's arguments with regard to how their instructions are not taught by the prior art, and, therefore, there can be no

anticipation are also similar to those proffered by Ngai *et al.* However, both the BPAI and the CAFC unequivocally and unambiguously disagreed with that argument.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Hemphill in order to provide appropriate instructions on how to use the bag based on the fact that the applicant's kit is known or otherwise obvious in the art as evidenced by Hemphill, and further in view of the CAFC's decision in *In re Ngai*.

**(10) Response to Arguments**

(A) With regard to claims 23-25 and 32 the appellant argues that the aluminum and polyethylene materials used in forming Hemphill's bag may be materials that release VOCs due to the process used to form these materials.

In response to this argument it is noted that in the 25 May 2007 final office action official notice was taken that aluminum was a material that inherently does not release significant amounts of VOCs. In their response filed 18 September 2007 the appellant states "...Applicant recognizes that the Examiner's official notice that aluminum foil is a material that does not release significant amounts of volatile organic compounds (VOCs)". This is clear acquiescence of the official notice statement. In their response the appellant did not timely traverse the taking of official notice. MPEP §2144.04 states:

If the applicant does not traverse the examiner's assertion of official notice or the applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art.

In the subsequent office action of 09 October 2007 it was clearly and unambiguously noted to the appellant that the official notice statement was considered factual information as the appellant did not timely traverse the taking of official notice. As such the appellant cannot now challenge that official notice, especially by providing mere undocumented, unproven allegations that aluminum may be made by variable processes.

Next, under the same argument, the appellant states that there is no teaching in Hemphill that the aluminum and polyethylene layers are "manufactured according to the same processes used to manufacture Appellant's bag". With regard to the VOC contribution of the materials of Hemphill's bag it is noted that the appellant's specification states:

The enclosed bag preferably has an inner liner formed of aluminum foil and an outer liner of polymeric material (e.g., polyethylene) such that the bag can be collapsible while samples are being withdrawn from the headspace. The foil lining can be made of material other than foil so long as it achieves the purpose of being vapor impermeable so as not to lead to inaccurate VOC measurements. It should be understood, however, that any bag is suitable for use herein so long as it can be safely stored at the requisite temperature and remain sufficiently collapsible for the samples to be withdrawn from the headspace above the sample for Flame Ionization Detection (FID) and does not contribute to the VOC measurement.

A thorough examination of the appellant's written description reveals no discussion of any preferred manufacturing process for either the aluminum or the polyethylene materials. In fact, the appellant's disclosure states that polyethylene is the preferred

polymer (and aluminum is the preferred metal foil) without any disclaimer to specific manufacturing methods.

Furthermore, the appellant's allegations regarding the characteristics of Hemphill's materials and the appellant's "manufacturing process" are not facts *per se*.

See MPEP §2145:

The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a *prima facie* case of obviousness.").

No previous argument or evidence has ever been made of-record (in the present application or in copending application 09/806,274) to show a) that the polyethylene material used in Hemphill's bag releases VOCs in a more than insignificant manner, and/or b) that the appellant's polyethylene is manufactured by any specific process to distinguish it over any other polyethylene material. In fact the appellant clearly indicates that polyethylene is a preferred material in a generic sense. Again, there is no discussion in the written description that discusses the appellant's preferred polyethylene materials to be from any specific manufacturing technique.

(B) With regard to claims 23-25 and 32 the appellant argues that there is no indication in Hemphill that the insulating paper layer does not release VOCs.

In response it was never stated in the rejection of the appellant's claims that the outer paper layer did or did not release VOCs. Rather, it was clearly and unambiguously stated in the final rejection that the removal of the paper layer would

have been an obvious expedient if the purpose for that layer was no longer desired. In Hemphill it is clearly stated that the purpose of paper layer is to insulate the bag and prevent burns to a user when hot grease is contained within the bag. If high temperature grease was not to be handled for disposal then the need for the paper layer is eliminated. One can certainly remove that layer during the bag's manufacture when it is not desired.

As stated in MPEP §2144.04 it is well established that the omission of an element and its corresponding function is an obvious operation. See, for example, *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (deleting a prior art switch member and thereby eliminating its function was an obvious expedient); *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) (Omission of additional framework and axle which served to increase the cargo carrying capacity of prior art mobile fluid carrying unit would have been obvious if this feature was not desired.); *Richards v. Chase Elevator Co.*, (1895) 159 U.S. 477, 486, 16 S. Ct. 53, 40 L.Ed. 225 (While the omission of an element in a combination may constitute invention if the result of the new combination be the same as before, yet if the omission of an element is attended by a corresponding omission of the function performed by that element, there is no invention if the elements retained perform the same function as before.). In *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989) the Board affirmed the rejection, holding that it would have been obvious to omit polybasic acid salts of the primary reference where the function attributed to such salt is not desired or required, such as in compositions for providing corrosion resistance in environments which do not encounter fresh water.

(C) With regard to claims 23-25 and 32 the appellant argues that the bag of Hemphill is non-analogous art.

In response it is noted that, in making this specious argument, the appellant states that Hemphill's bag is for grease disposal and would not be within the purview of a chemical engineer. The appellant is apparently relying on *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."). The appellant mistakenly omits other more pertinent deciding factors with regard to determining analogous art. As stated in MPEP §2141.01(a):

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue." In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

While Patent Office classification of references and the cross-references in the official search notes of the class definitions are some evidence of "nonanalogy" or "analogy" respectively, the court has found "the similarities and differences in structure and function of the inventions to carry far greater weight." *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) (The structural similarities and functional overlap between the structural gratings shown by one reference and the shoe scrapers of the type shown by another reference were readily apparent, and therefore the arts to which the reference

patents belonged were reasonably pertinent to the art with which appellant's invention dealt (pedestrian floor gratings).

The appellant's bag and the bag of Hemphill are formed of similar materials, they both are collapsible, they both have a headspace, they both are sealable, and they both have instructions. It is clear that the bag of Hemphill is reasonably pertinent to the appellant's bag as it has the necessary structural similarities and storage functionality. It is, therefore, analogous art whether or not the appellant's chemical engineers would ever look to the food disposal art for a solution to their problem. Finally, any person having ordinary skill in the art, including chemical engineers, would most assuredly look at Hemphill's bag and conclude that it is indeed pertinent to the claimed subject matter.

(D) With regard to claims 23-25 and 32 the appellant argues that it has not been established that there were design incentives or market forces that would prompt one skilled in the art to modify Hemphill's bag.

In response it is first noted that obviousness under 35 U.S.C. 103(a) need not be established any one or more of the rationale stated in the Office's *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of the Supreme Court Decision in KSR International Co. v. Teleflex, Inc.* In fact, the Guidelines specifically state

If the search of the prior art and the resolution of the Graham factual inquiries reveal that an obviousness rejection may be made using the familiar teaching-suggestion-motivation (TSM) rationale, then such a rejection using the TSM rationale can still be made. Although the Supreme Court in KSR cautioned against an overly rigid application of TSM, it also recognized that TSM was one of a number of valid rationales that could be used to determine obviousness. Office personnel should also consider whether one or more of the other rationales set forth below support a conclusion of obviousness. Note that the

list of rationales provided below is not intended to be an all-inclusive list. Other rationales to support a conclusion of obviousness may be relied upon by Office personnel.

See also *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161, 82 USPQ2d 1687, 1690-91 (Fed. Cir, 2007) (An obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious).

As noted above obviousness of the appellant's claim 24 has been established by virtue of the teachings of Hemphill and the prior decisions of the Board, the Court of Customs and Patent Appeals, and the Supreme Court. Irrespective of which "rationale" in the Guidelines is used or not used in the rejection of the appellant's claims it is noted that neither the decision in *KSR* nor the Guidelines themselves change or are otherwise in conflict with prior decisions including those of *Kuhle*, *Larson*, *Wu*, and *Richards* discussed above. These decisions clearly affirm that eliminating the paper layer of Hemphill's bag is obvious if the function of that layer is not desired.

Furthermore, the appellant appears to be focusing their argument on a particular section of the Office's Guidelines. In particular the appellant is attempting to show that obviousness has not been shown under one specific rational, namely:

"Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

- (1) a finding that at the time of the invention, there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem;
- (2) a finding that there had been a finite number of identified, predictable potential solutions to the recognized need or problem;

- (3) a finding that one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success; and
- (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The appellant argues that the first element that needs to be met under this guideline was not met. The issues of design need and market pressure are only exemplary of the possible reasons to support an obvious to try rationale. The Guideline's are not so rigid that design need and market pressure must be identified so as to properly support an obviousness rejection under this rationale. An obvious to try rationale, within the purview of the facts of the instant application and the references of-record, is one where the appellant's need for a two-ply bag, and faced with a similar bag in the prior art, would have a finite number of choices to obtain that bag.

The problem facing the appellant was the forming of a substantially VOC-free, sealable, two-ply bag having an inner metal foil and an outer polymer layer capable of being maintained at the mean exit temperature of the emissions of a process system. When faced with the teachings of Hemphill one of ordinary skill would recognize that the sole option necessary to obtain the necessary bag is the removal of the outer paper layer. No other alterations or changes are needed. Clearly, from Hemphill, there is a reasonable expectation of success to one of ordinary skill in the art that removing the outer paper layer would produce a bag that is capable of meeting the needs of the appellant. This is even more so considering that claims 23 and 25 do not recite anything with regard to temperature. With regard to claim 24 the bag, as claimed, merely has to be capable of being stored at the exit temperature of the emissions of a

process system. The temperature in the claim is not defined as being within a certain range, but only has to be one that can be determined for a given process system (which can be open or closed). See *Ex parte Beimesch*, appeal number 2004-0829, at page 4.

In addition to the above rationale it is noted that the Guidelines further include the following additional rationale:

Some Teaching, Suggestion, or Motivation in the Prior Art That Would Have Led One of Ordinary Skill To Modify the Prior Art Reference or To Combine Prior Art Reference Teachings To Arrive at the Claimed Invention

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was reasonable expectation of success; and
- (3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

With regard to element (1) one of ordinary skill in the art would have the general knowledge that the outer paper layer of Hemphill's bag is for preventing burns when handling hot grease (this is the sole reason for the paper layer as taught explicitly in Hemphill). A person of ordinary skill in the art would have the general knowledge to know that, if hot grease (or other hot materials) would not be handled then the need for the outer paper layer can be eliminated. The elimination of the paper layer does not, in any way, keep Hemphill's bag from storing grease or any other materials (hot or otherwise). Therefore there is a clear reasonable expectation of success that the elimination of the outer paper layer would produce a bag that is still capable of holding

and storing materials, including hot grease. The paper layer does not affect holding and storing functionality of Hemphill's bag.

(E) With regard to claims 23-25 and 32 the appellant argues that it the modification of the Hemphill bag would render the bag unusable for its intended purpose.

In response the appellant is mistakenly equating the outer paper layer with the ability to hold and store hot grease. A thorough reading of Hemphill clearly shows that the sole purpose of the paper outer layer is for protecting a user from getting burned. Hemphill does not disclose or otherwise teach that the paper layer actually enables the bag to hold and store hot grease. Rather, it is the metal foil and the polyethylene layers, in combination perhaps with the ability of the bag to be sealed, that allows hot grease to be held and stored.

(F) With regard to claims 23-25 and 32 the appellant argues that it the modification of the Hemphill bag assumes that burn protection is not a concern with the instant application.

In response it is well established that the motivation to alter the prior art can be different from that of the appellant. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Furthermore, it is noted that the appealed claims make no reference to a specific temperature in which to use the bag. Claims 23 and 25 are silent with regard to any temperature requirement,

and claim 24 limits the bag to one that is capable of being stored "at the exit temperature" of a process system. The exit temperature can be any temperature as long as it can be determined for a given process system (which can be open or closed). See *Ex parte Beimesch*, appeal number 2004-0829, at page 4.

(G) With regard to claims 23-25 and 32 the appellant argues that they "discovered" that a two ply bag having aluminum and polymer was sufficient to protect users from being burned.

In response a thorough reading of the appellant's specification reveals that nowhere is the burning (or lack thereof) of a user discussed. In fact, the written description is completely silent with regard to handling of the seal by anyone. The appellant has established no factual basis for such an allegation, and there is nothing of-record to indicate how the appellant handles the high temperature bags.

(H) With regard to claims 26-31, 33, and 34 the appellant merely states that the prior art of Hemphill does not teach the specific instructions as claimed.

In response the Board is asked to review and apply the precedential decision *In re Ngai*, 70 USPQ 2d 1862. The CAFC analyzed Ngai *et al.*'s claim 19 and determined that the elements that formed the kit included a premeasured portion of reagent (buffer) and instructions on how to use the reagent. The cited prior art was a kit having a buffer and specific instructions on how to use the buffer, albeit different instructions.

The CAFC affirmed the Board of Patent Appeals and Interferences and concluded that Ngai *et al.*'s claimed kit was distinguished from *In re Gulack*, 703 F.2d 1381 [217 USPQ 401] (Fed. Cir. 1983). Rather Ngai *et al.*'s kit was found to have been

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anticipated by the cited prior art (the buffer with instructions) despite the fact that Ngai *et al.*'s claim 1 method was distinct from the instructions in the prior art. In fact, the method of claim 1 was determined to be patentable over the prior art.

The CAFC concluded that Ngai *et al.*'s instructions merely taught how to use the reagent component of the kit (the buffer). Specifically, the CAFC concluded:

"All that the printed matter does is teach a new use for an existing product."

and

"He [Ngai] is not, however, entitled to patent a known product by simply attaching a set of instructions to that product."

In the present application the appellant's instructions merely teach a different use for a known sealable bag. The appellant's claimed bag does not depend on the claimed instructions in order to function; i.e., the instructions do not enable the bag to hold a sample. Likewise, the claimed instructions do not depend on the bag in order to instruct someone how to sample. Therefore, the appellant's instructions do not enable any sealable bag from holding any material and only describe a process to store a sample in the bag and then to sample the headspace of the bag. The appellant's claims to a kit comprising a bag and instructions to use the bag is clearly analogous to Ngai *et al.*'s kit. The appellant's arguments with regard to how their instructions are not taught by the prior art, and, therefore, there can be no anticipation are also similar to those proffered by Ngai *et al.* However, both the Board and the CAFC unequivocally and unambiguously disagreed with that argument.

#### **(11) Related Proceeding(s) Appendix**

The appellant's related proceedings appendix is incomplete.

This application is a divisional of copending application 09/806,274 which is now at the Board of Patent Appeals and Interferences for the second time. On 19 March 2004 the Board reversed the rejections of the 09/806,274 claims which included both process- and apparatus-type claims. After the Office reopened prosecution of the 09/806,274 application the appellant filed this application to pursue the apparatus claims, and left the process claims pending and under appeal in the 09/806,274 application.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/David A. Rogers/  
Primary Examiner, Art Unit 2856

Conferees:

/Hezron Williams/

Supervisory Patent Examiner, Art Unit 2856

/Brian Sircus/  
Brian Sircus  
TQAS, TC 2800